

6,119,106); and claims 5-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky in view of Barzilai et al.

The Applicant notes with appreciation the granting of a brief interview on April 1, 2002 with the Examiner. The arguments set forth below were generally presented to the Examiner, but no conclusions were reached during the interview. The Examiner asked that the oral argument presented be embodied in a response to the Office Action.

New claim 26 has been added to the application and no claims have been amended. Therefore, claims 1-26 are present for examination. Applicant respectfully requests reconsideration of this application in its current form.

35 U.S.C. §102 Rejection in View of Mersky et al.

Claims 1-4 are rejected under 35 U.S.C. §102(e) as being anticipated by Mersky et al. (U.S. Patent No. 6,119,106). For this rejection to be proper, Mersky et al. must teach or suggest every limitation of these claims. Applicants respectfully disagree with the rejection based upon the quoted portions of the Mersky et al. reference (hereinafter "Mersky") as several limitations of Claim 1 are not taught or suggested by Mersky. More specifically, Mersky fails to teach or suggest: (1) "contacting the money order system via the internet by a user," (2) "transmitting information to the money order system via the internet to purchase said money order," and (3) "sending said generated money order to said intended receiver." For at least these reasons, Applicant respectfully requests reconsideration of the rejection.

In col. 3, lines 25-34, or col. 11, lines 15-32, of Mersky teach that their invention could be used to purchase money orders "at an agent site" 10. See col. 11, line 21. The agent system 4 further includes a peripheral printer or other device to generate the money order. See col. 11, lines 23-25. The agent system 4 processes the purchases and transmits information to the host system 6. See col. 11, lines 26-27. Reports are sent by the host system 6 to the money order company (not shown in the figures). See col. 11, lines 27-30. The service provider or host system 6 pays the money order and receives payment from any of the agent systems 4. See col. 11, lines 30-32.

The ability to buy a money order from an agent store where it is printed locally described in Mersky is largely described in the background section of the present application. See page 2, lines 12-13. This is the conventional processes where a user visits a physical store, in-person, to purchase a money order that is printed locally. Banks, the postal service, convenience stores, and grocery stores typically offer this service.

The claimed invention is appreciably distinct from the Mersky and conventional systems. With the claimed invention, there is no need to visit a physical store and no need to address and stamp an envelope to send the money order to the intended receiver. Clear advantages over Mersky that have eased payments, especially, payments for auction goods.

For the following reasons, Mersky does not teach or suggest limitations required by the invention of claim 1. First, the claimed invention requires “contacting the money order system via the internet by a user”, whereas Mersky teaches a user visiting a physical agent site **10** to get the money order. Second, the claimed invention requires “transmitting information to the money order system via the internet to purchase said money order,” whereas no information passes over the internet in Mersky as part of the purchase of the money order. The user, the agent taking the information and the printer are co-located in Mersky such that there is no need to transport information over the internet during the purchase process. Finally, the claimed invention requires “sending said generated money order to said intended receiver,” but Mersky does not teach sending the money order and only teaches printing it for the user at the agent site.

35 U.S.C. §103 Rejection in View of Mersky et al. and Barzilai et al.

Claims 5-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mersky et al. in view of Barzilai et al. (6,012,045). As described in the preceding section, Mersky cannot be relied upon to teach the remote purchase of a money order limitations of claims 5-22. Even if combined with Barzilai et al., these references do not teach or suggest all limitations of the claims. Further, the Applicant reiterates the position that the obviousness rejection lacks a proper showing of a motivation to combine

Mersky et al. with Barzilai et al. More specifically, this combination would not occur to one of ordinary skill in the art at the time the invention was made without the benefit of hindsight reconstruction gleaned from the Applicant's patent application. In other words, the applicant reiterates that a *prima facie* case of obviousness shown below has not been shown:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP 2143.

The obviousness rejection is based upon a combination of Mersky et al. with Barzilai et al. Specifically, Mersky et al. is cited for teaching purchasing a money order over the internet and Barzilai et al. is cited for teaching of electronic payment on online bidding, sales, and auctions. As is made clear in the preceding section, Mersky cannot be relied upon for these teachings. Accordingly, the combined references do not teach all the limitations claimed. Reconsideration of the rejection in light of the above Mersky arguments is respectfully requested.

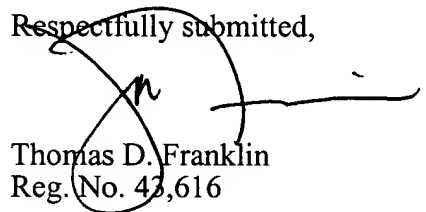
As best understood by the Applicant, the Office Action concludes that it is proper to combine the teachings, but apparently relies upon official notice to combine these references (see page 7, last paragraph, of the Office Action). This official notice does not address the express teaching away in Mersky et al. pointed out in the response to the last Office Action. If official notice is being proposed and maintained for the proposition that it is well known that Mersky et al. could be combined with Barzilai et al., Applicants respectfully traverse this official notice and hereby request an express showing of documentary proof of this proposition as set forth in MPEP 2144.03. Further, the Applicants request specific addressing of why the express teach away in Mersky et al. can be overcome by this official notice. See MPEP 2141.02 for a discussion of teaching away.

As first stated in the response to the first Office Action, Mersky et al. teaches away from online payment by a user by arguing that systems relying upon computers or other devices for electronic funds transfer are unavailing for customers who do not have either a computer or other communication device, or a checking account or other bank account. See col. 1, lines 55-58. Mersky et al. further explains that such systems do not accommodate customers that desire, or are only able, to pay creditors with cash. See col. 1, lines 58-63. Accordingly, reconsideration of the motivation to combine these references is respectfully requested in light of the express teaching away.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 303-571-4000.

Respectfully submitted,



Thomas D. Franklin
Reg. No. 42,616

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
TDF:cmb

Stephen Chin
Application No.: 09/307,486
Page 12



PATENT

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

--26. (New) A method of purchasing a money order via the internet as recited in claim 1, wherein the sending step is initiated by the money order system.--

DE 7063544 v1

RECEIVED

APR 11 2002

Technology Center 2100